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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,096	07/05/2001	Michael A. DeNatale	7157	4443

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PAUL M. DENK
763 South New Ballas Road
St Louis, MO 63141

EXAMINER

LEE, JINHEE J

ART UNIT PAPER NUMBER

2831

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/900,096		DENATALE, MICHAEL A.	
	Examiner		Art Unit	
	Jinhee J Lee		2831	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action is in response to Appeal Brief filed 6/16/03.
2. The finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.
3. This is a non-final Office action. If the finality of the previous Office action had not been withdrawn, the applicant would have received a notice of defective appeal brief. Appeal brief fails to group the claims according to the grouping of the previous Office action. For example: Claim 1 can not be in the same group as claims 2-5, since claim 1 was rejected with a 102 rejection. Claims 2-3 and 4-5 also needs to be separately grouped, since claims 2-3 was rejected based on a separate 103 rejection than 4 and 5.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1-13 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

6. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "a series of foldable panels" in line 5. This is confusing. Is this same or different than "a series of panels" in line 3?

Claim 1 recites the limitation "the approximate structure" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the said" in line 3. This is confusing.

Claim 6 recites the limitation "locked into closure" in line 5. This is confusing.

Claim 12 recites the limitation "each angle" in line 2. This is confusing.

Examiner suggests "each of said angle" to clarify.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Boer (5603370).

Re claim 1 (as best understood), Norman et al. discloses a secure cage being formed of a series of panels (16, 20 for example) capable of being erected into its space providing structure, or folded and collapsed as during non-use, a series of foldable panels, said panels being folded into an erected polygonal shape, said panels for the

cage forming a pair of side panels (16, 20 for example), and at least two front panels (16, 20 for example) pivotally attached to one another, the side panels capable of securing to the approximate structure, the front panels capable of being locked into a protective configuration, and said front panels in conjunction with the side panels fold back to provide access to any cables maintained (see figures 1-2). Also, note that it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

PR 7/28/03 10. Claims 2, 3, 12-1⁸₈ are rejected under 35 U.S.C. 103(a) as being unpatentable over Boer in view of Norman et al. (6070372) and further in view of Laetsch (6292556).

Re claim 2, Boer substantially discloses a secure cage as set forth in claim 1 above. Boer does not disclose the side panels of the cage being permanently secured to a side of a structure, and the front panels capable of being locked into position for providing security and protection for any cables therein, and further capable of being opened to provide access to the cables for servicing and that the structure is a manhole and that the cage locates within a manhole structure of the type provided for accommodating a plurality of fiber optic cables. However Norman et al. teaches of side

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panels of the cage being permanently secured to a side of a structure, and the front panels capable of being locked into position for providing security and protection for any cables therein (see figure 4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the cage of Boer with the structure of Norman et al. in order to provide auxiliary room. Also, Laetsch teaches of cages (protectors, see column 4 lines 21-23 according to the numbering in the middle) in manhole structure. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the cage of Boer/Norman et al. in a manhole of Laetsch in order to provide housing for transmission wires. Also, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed, such as being located within a manhole, does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Also, note that it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Re claim 3, Boer substantially discloses a secure cage as set forth in claim 1 above. Boer does not disclose one of said side panels being permanently affixed to a side of the structure, and another of said side panels being normally fastened and locked to the side of the structure, but capable of being opened, to provide for folding of the various cage panels into a non-usable position to provide access to the cables during servicing and that the structure is a manhole and that said cage is being provided

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within a manhole structure. However, Norman et al. teaches of cages with one of said side panels being permanently affixed to a side of the structure, and another of said side panels being normally fastened and locked to the side of the structure, but capable of being opened, to provide for folding of the various cage panels into a non-usable position to provide access to the cables during servicing (see figures 3 and 4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the cage of Boer in the structure of Norman et al. in order to provide auxiliary room. Also, Laetsch teaches of cages (protectors, see column 4 lines 21-23 according to the numbering in the middle) in a manhole structure. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the cage of Boer/Norman et al. in a manhole of Laetsch in order to provide housing for transmission wires. Also, note that it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Re claim 12, Boer substantially discloses a secure cage as set forth in claim 1 above. Boer does not disclose that an edge of each side panel that secures to a side of the manhole structure includes an angle, and each angle capable of fastening to the side of the manhole. However, Norman et al. teaches of side panel that secures to a side of a structure. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the structure of Norman et al. on the cage of Boer in order to provide an auxiliary room. Also, Laetsch teaches of cages in a

manhole structure. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the cage of Boer/Norman et al. in a manhole of Laetsch in order to provide housing for transmission wires. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide angle on an edge of side panel capable of fastening to an angled manhole, since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954). Also, note that it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Re claim 13, note that the secure cage of Boer includes one edge of one side panel with an angle (90 degrees for example) and is capable of being rigidly fastened to a side of the manhole, while an edge of the opposite side panel is capable of being removably locked to the side of the manhole structure during installation and erection of the secure cage (see figures 1-2). Also, note that it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Re claim 14, Boer substantially discloses a secure cage comprising: a pair of side panels, each having a defined thickness; at least two front panels hingedly attached to one another and each hingedly attached to one of the side panels and each having a defined thickness; wherein the side panels and the front panels are adapted to

collapse to form a substantially flat structure having a thickness substantially equal to the sum of the thicknesses of each of the side panels and front panels and an outer dimension substantially equal to the largest of the front and side panels. Boer does not explicitly disclose at least one attachment device attached to each side panel opposite its connection to the front panel for attachment to the manhole structure; at least one pivotal latch attached to the front panels adjacent their attachment to one another wherein the pivotal latch may be latched when the front panels have been pivoted into place to form substantially a single plane and the pivotal latch, when latched, provides retention of the two panels in alignment in substantially the single plane and panels folded to facilitate insertion into the manhole structure. However, Norman et al. teaches of at least one attachment device attached to each side panel opposite its connection to the front panel for attachment to the structure (180 for example); at least one pivotal latch attached to the front panels adjacent their attachment to one another wherein the pivotal latch may be latched when the front panels have been pivoted into place to form substantially a single plane and the pivotal latch, when latched, provides retention of the two panels in alignment in substantially the single plane (240, 250 for example) (see figures 3-4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the structure of Norman et al. on the cage of Boer in order to provide an auxiliary room. Also, Laetsch teaches of cages in a manhole structure. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the cage of Boer/Norman et al. in a manhole of Laetsch in order to provide housing for transmission wires. Further, it has been held that a

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recitation with respect to the manner in which a claimed apparatus is intended to be employed, such as facilitated for location within a manhole, does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re claim 15, note that Norman et al. teaches of a hasp device as an attachment device (see figures 3 and 4).

Re claim 16, note that Norman et al. Teaches of an attachment device with at least one angle (i.e. 90 for example) (see figures 3 and 4).

Re claim 17, note that Boer discloses front and side panels attached by hinges (see figures 1-2).

Re claim 18, note that Boer discloses front and side panels attached by flexible member (see figures 1-2).

11. Claims 4-11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boer in view of Norman et al. and Laetsch, as applied to claims 2, 3 and 14 above, and further in view of Cucksey (4880210).

Re claim 4, the device of Boer as modified by teachings of Norman et al./Laetsch discloses a cage as set forth in claims 2 and 3 above. It does not explicitly disclose a cage wherein said panels include a series of perforations to provide ventilation to the cables disposed therein. However, Cucksey teaches of a cage with perforations. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the cage with perforations of Cucksey on the cage of Boer/Norman et al./Laetsch in order to receive rod (see claim 4).

Re claim 5, the device of Boer as modified by teachings of Norman et al., Laetsch and Cucksey substantially discloses a secure cage as set forth in claim 4 above. Norman et al./Laetsch/Cucksey does not disclose that the cage is provided for protecting the spliced dedicated cables for an individual customer. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed, such as provided for protecting the spliced dedicated cables for an individual customer, does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re claim 6, note that the device of Boer includes secure cage wherein the front panel includes a pair of front panels, said front panels having sides, said front panels, along one side (along 16 for example), being hinged together, and said front panels at their other sides being hinged to the side panels for the said cage, whereby all of said panels may be folded into a collapsed and substantially flattened condition when the cage is opened during servicing of the cables, but can be erected and locked into closure to provide protection and securement for any cables installed therein (see figures 1-2).

Re claim 7, note that the device of Norman et al. teaches of a secure cage wherein its panels are formed of a lightweight material (see column 5 lines 54-57).

Re claim 8, note that the device of Norman et al. teaches of a secure cage wherein its panels are formed of aluminum (see column 5 lines 54-57).

Re claim 9, the device of Boer as modified by teachings of Norman et al., Laetsch and Cucksey substantially discloses a secure cage as set forth in claim 7

above. Boer/Norman et al./Laetsch/Cucksey does not disclose that the panel is formed of a rigid polymer. The examiner takes Official Notice that rigid polymer is well known in the electrical arts for its protective properties. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a panel of rigid polymer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Re claim 10, the device of Boer as modified by teachings of Norman et al., Laetsch and Cucksey substantially discloses a secure cage as set forth in claim 7 above. Boer/Norman et al./Laetsch/Cucksey does not disclose that each secure cage has a dimension of approximately four feet wide, and one to two feet deep, and five feet in height. It would have been an obvious matter of design choice to use each secure cage that has a dimension of approximately four feet wide, and one to two feet deep, and five feet in height, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Re claim 11, the device of Boer as modified by teachings of Norman et al., Laetsch and Cucksey substantially discloses a secure cage as set forth in claim 10 above. Boer/Norman et al./Laetsch/Cucksey does not disclose that each panel of the secure cage is approximately five feet in height, and 18 to 24 inches in width. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use each panel of the secure cage that is 18 to 24 inches in width, since it has

been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Re claim 19, the device of Boer as modified by teachings of Norman et al./Laetsch discloses a cage as set forth in claim 14 above. It does not explicitly disclose a cage wherein said panels include a series of perforations to provide ventilation. However, Cucksey teaches of a cage with perforations. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the cage with perforations of Cucksey on the cage of Boer/Norman et al./Laetsch in order to receive rod (see claim 4).

Response to Arguments

12. Applicant's arguments with respect to claims 1-13 have been considered but are not persuasive.

In response to applicant's argument that a secure cage is not a display system, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In response to applicant's argument that the cited prior art does not disclose or teach device capable of locking, examiner disagrees. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

In response to applicant's argument that a ventilation is not provided and the device is located in a manhole, Examiner disagrees. The prior art shows perforations, similar to the disclosure by the applicant. Also, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, cables are commonly used around display systems.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

13. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinhee J Lee whose telephone number is 703-306-0154. The examiner can normally be reached on M, T, Th and F at 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean A Reichard can be reached on 703-308-3682. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

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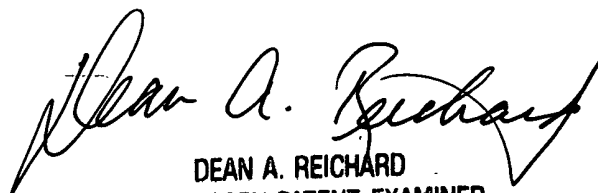
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872-9318 for regular communications and 703-872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

jji
July 25, 2003

 7/28/03

DEAN A. REICHARD
SUPERVISORY PATENT EXAMINER
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